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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,921	07/14/2003	Howard W. Lisby JR.	0461M-001	7975

7590 08/02/2004

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,921

Applicant(s)

LISBY, HOWARD W.

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) 7-9 and 17 is/are withdrawn from consideration.
5) ☒ Claim(s) 14 is/are allowed.
6) ☒ Claim(s) 1,4-6,11-13,15,16 and 18-21 is/are rejected.
7) ☒ Claim(s) 2,3 and 10 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 7-9 and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 18 June 2004.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a plug is adapted to receive a tang in a plurality of angular positions about a longitudinal axis in claim 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief

description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 5 it is not understood how a plug is adapted to receive a tang in a plurality of angular positions about an axis. The specification and drawings do not show this.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6, 13 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 13 recite the limitation "a cap having a dimension larger than an outside dimension of the shaft". There is insufficient antecedent basis for this limitation in the claim. The specification discloses a cap 18 which has an outside diameter larger than the interior of the shaft 25 on page 7 lines 21-22. Claim 18 is indefinite in that the term "may" in line 15 is indefinite. It is uncertain if the function referring to can be performed or not. The examiner recommends removing this word to remove this rejection.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Torelli.

Torelli discloses a ball retrieval tool having an elongated handle in the form of a pole (150) having a longitudinal axis (Fig. 2), a body in the form of a bottom side (116) coupled to one end of the handle and extending substantially parallel to a longitudinal axis (Figs. 1-2), a shelf in the form of a top side (114) disposed on an end of the body distal the handle substantially perpendicular to a body (Figs. 1-2), a backstop in the

form of a side side wall (114) coupled to a shelf and disposed substantially perpendicular to both a shelf and a body (Figs. 1-2), a body, shelf and backstop define an open-cornered support for a ball in the form of the corner being open to the surrounding area to the retriever (Fig. 1), and coupling means for coupling a tool to a handle (Col. 3, Lns. 42-47).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-5, 11-12, and 15-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torelli in view of Tarrant.

Torelli discloses an opening to allow a ball to enter at the distal end of the tool (Fig. 1), a method of allowing a user to engage a ball into a recess (112) from a front side of a frame (Fig. 1) to entrap a ball into a frame and scooping a ball into a frame (Col. 1, Lns. 40-63).

Tarrant disclose a tang (22) extending longitudinally from a proximate end of a body (28), a plug (18) coupled to a shaft inside a handle (Fig. 8), a plug surrounding and defining a slot (21) adapted to receive and frictionally grasp a tang (Col. 5, Lns. 36-42), a golf club having a head (Fig. 1), a plug adapted to receive a tang in a plurality of

angular positions in the form of being able to make new angular slots in a plug (Ref. No. 18, Fig. 3), a method of inserting a tang into a slot, pressing a tool towards a handle (Fig. 3), a method of grasping an end of the handle opposite the tool, and lowering the tool into a cup containing a ball (Figs. 7-8).

In view of the patent of Tarrant it would have been obvious to modify the ball retriever of Torelli to have a coupling means being removable with a tang extending longitudinally from a proximate end of a body, a plug coupled to a shaft inside a handle adaptable to receive a tang in a plurality of angular positions, a plug surrounding, defining a slot adapted to receive and frictionally grasp a tang, a method of inserting a tang into a slot, and pressing a tool towards a handle in order to attach a retriever tool to a handle end of a golf club.

In view of the patent of Tarrant it would have been obvious to modify the method of ball retriever of Torelli to have steps of grasping the end of the handle opposite the tool, lowering the tool into a cup containing a ball, positioning a shelf near a lower portion of a ball, tilting a handle to urge a ball onto a shelf and raising a handle upward to retrieve a ball from a club in order to utilize the scooping procedure for a ball in a club so a player does not have to bend over to get a ball out of a cup.

11. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torelli in view of Tarrant as applied to claims 4-5, 11-12, and 15-16 above, and further in view of Huiskamp.

Torelli lacks a plug having a cap having a dimension larger than an outside dimension of a shaft.

Huiskamp discloses plug for a weight having a cap larger than an outside dimension of a shaft (Fig. 1). In view of Huiskamp it would have been obvious to modify the plug of Torelli to have a cap larger than an outside dimension of a shaft in order to ensure plug does not go too far into the shaft.

12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torelli in view of Tarrant and Berndt.

Torelli lacks a method having steps of grasping a grip and laying a head onto the ground, laying a club down substantially parallel to the ground until the tool contacts the ground whereby a gap remains between a grip and the ground, and retrieving the club from the ground by inserting lifting means between a grip and the ground and lifting the grip.

Berndt discloses a method having steps of laying a club down substantially parallel to the ground until the tool contacts the ground whereby a gap remains between a grip and the ground (Fig. 2) in order to not compromise the effectiveness of a future stroke due to water or dirt being on the grip (Col. 1, Lns. 14-26). Clearly an artisan would use a suitable steps of placing a club on the ground and picking it up in which steps of grasping a grip and laying a head onto the ground and retrieving the club from the ground by inserting lifting means in the form of hands between a grip and the ground and lifting the grip are included. In view of the patent of Berndt it would have

been obvious to modify the method of Torelli to have steps of grasping a grip and laying a head onto the ground, laying a club down substantially parallel to the ground until the ball retriever tool contacts the ground whereby a gap remains between a grip and the ground, and retrieving the club from the ground by inserting lifting means between a grip and the ground and lifting the grip in order to not compromise the effectiveness of a future stroke due to water or dirt being on the grip.

Allowable Subject Matter

13. Claims 2-3, and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to claims 2-3, none of the prior art discloses or renders as obvious a plurality of prongs disposed on and extending from a shelf opposite the back stop in addition to the other elements of structure claimed. With respect to claim 10, none of the prior art discloses or renders as obvious a backstop is disposed on an end of the shelf a spaced distance apart from the body to define a gap adapted to receive storage means for the tool in addition to the other elements of structure claimed.

14. Claim 14 is allowed. None of the prior art discloses or renders as obvious a plurality of prongs disposed on and extending from a shelf opposite the back stop in addition to the other elements of structure claimed.

15. Claims 18-20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. None of the prior art discloses or renders as obvious a plurality of prongs disposed on and extending from a shelf opposite the back stop in addition to the other elements of structure claimed.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 30 July 2004



STEPHEN BLAU
PRIMARY EXAMINER